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Our Case No. 10466/134
P2548P1C15

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Filvaroff et al.)
U.S. Patent Application Serial No. **09/944,884**) Examiner: **Ruixiang Li**
Mailing Date of Notice of Allowance : **7/14/04**) Group Art Unit No. **1646**
Filing Date: **August 31, 2001**)
Title: **SECRETED AND TRANSMEMBRANE**)
 POLYPEPTIDES AND NUCLEIC ACIDS)
 ENCODING THE SAME)

APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705(b)

Mail Stop Patent Ext
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

05/31/2006 YPOLITE2 00000003 09944884

Reconsideration of the patent term adjustment under 35 U.S.C. § 154(b) is requested.

200.00 OP

- (1) The fee required as set forth in 37 C.F.R. § 1.18(e) is attached herewith.

Patent No. 7,018,837

Date Filed: Aug. 31, 2001

Mail Date of Notice of Allowance: July 14, 2004

(2) A statement of the facts involved:

- (i) According to the Issue Notification received March 14, 2006, the term of adjustment for U.S. Patent No. 7,018,837 is **534** days. Correction of the patent term adjustment to add an additional **277** days to the patent term is respectfully requested. Thus, Applicants respectfully submit that the proper total patent term adjustment for this patent is **811** days.

The provisions of 37 C.F.R. § 1.702(a)(1)(2) provide the basis for term adjustment of **284** days as set forth in the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).

The provisions of 37 C.F.R. § 1.702(a)(6) provide the basis for **417** days of term adjustment as explained below.

The provisions of 37 C.F.R. § 1.702 (b) provide the basis for **157** days of term adjustment as explained below.

The above-identified days must be decreased by any applicant delay pursuant to 37 C.F.R. § 1.704. As discussed below, Applicants are assessed **47** days of delay. Therefore, the proper calculation for determining the number of days of patent term adjustment to be awarded in this case is as follows: **(284 + 417 + 157) – 47 = 811**, as explained below.

- (ii) The relevant dates, as specified in 37 C.F.R. §§ 1.703(a), for which an adjustment is awarded in the Notice of Allowance and Issue Fee Due are as follows:

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- a) The period of adjustment under 37 C.F.R. § 1.703(a)(1) is the number of days, if any, in the period beginning on the day ("the fourteen month date") after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. § 111(a) of fulfilled the requirements of 35 U.S.C. § 371 (the fourteen-month date) and ending on the date of mailing of either an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151, whichever occurs first.

1. The present application was filed on **August 31, 2001**.

The fourteen-month date determined pursuant to 37 C.F.R. § 1.703(a)(1) is **October 31, 2002**.

2. The first notification under either 35 U.S.C. §§ 132 or 151 was not mailed until **August 11, 2003**, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).
3. Thus, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A), under 37 C.F.R. § 1.702(a)(1), Applicants are entitled to **284** days of patent term extension.

(iii) The relevant dates, as specified in 37 C.F.R. §§ 1.703(a)(6), for which an adjustment is sought are as follows:

- a) The period of adjustment under 37 C.F.R. § 1.703(a)(6) is the number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was

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paid (the "four month date") and all outstanding requirements were satisfied and ending on the date a patent was issued.

1. The issue fee payment was verified on **October 4, 2004** as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A). The four month date determined pursuant to 37 C.F.R. § 1.703(b) is **February 4, 2005**.
2. The patent issued on **March 28, 2006**.
3. Therefore, Applicants are entitled to an additional **417** days of patent term extension.

(iv) The relevant dates, as specified in 37 C.F.R. § 1.703 (b), for which an adjustment is sought are as follows:

- a) The period of adjustment under 37 C.F.R. § 1.703 (b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date (the three year date) on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application (the "three year date") and ending on the date a patent was issued. This period does not include any days due to a request for continued examination, a declaration of interference, suspension of prosecution due to an interference, maintaining the application in a sealed condition, application of a secrecy order, or time spent appealing a final rejection to the Board of Patent Appeals and Interferences.

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1. The application was filed on **August 31, 2001**.
Therefore, the three year date is **August 31, 2004**.
2. The application issued as U.S. Patent No. 7,018,837 on **March 28, 2006**. The issue fee payment in this case was verified on **October 4, 2004**. Therefore, to avoid overlapping delay calculations, the time period from four months after payment of the issue fee (February 4, 2005) until issuance of the patent is calculated under 37 C.F.R. § 1.702(a)(6) and is not accounted for under this calculation. Thus, the period for adjustment under 37 C.F.R. § 1.702(b) is from **August 31, 2004** to **February 5, 2005**, which is **157 days**.

- (v) U.S. Patent Application Serial No. 09/945,584 is not subject to any terminal disclaimer.
- (vi) Circumstances during the prosecution of the application resulting in the patent that constituted a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704(b) include the following:
 - a) The Office mailed a First Non-Final Rejection on **August 11, 2003**. Applicants mailed an Amendment and Response on November 11, 2003, which was filed at the Office on **November 14, 2003**, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A). Any response filed after the date that is three months after the date a rejection is mailed is subject to the provisions of 37 C.F.R. § 1.704(b). Indeed, the period of adjustment set forth in § 1.703

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shall be reduced by the number of days, if any beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying Applicant of the rejection and ending on the first day the reply is filed. Therefore, the adjustment set forth in § 1.703 must be reduced 3 days based on this transaction.

- b) The Office mailed a Final Rejection on **February 11, 2004**. Applicants mailed an Amendment and Response on April 11, 2004, which was filed at the Office on **April 15, 2004**, as evidence by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A). Because the Amendment and Response were submitted within two-months of mailing of the final rejection, the Examiner was required to respond with a Notice of Allowance or an Advisory Action. On **May 6, 2004** the Office mailed an Advisory Action. Applicants submitted an Amendment and Response to the Advisory Action on **June 24, 2004**, which was filed the same day. Any response filed after the date that is three months after the date a rejection is mailed is subject to the provisions of 37 C.F.R. § 1.704(b). Indeed, the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying Applicant of the rejection and ending on the first day the reply is filed. Therefore, the adjustment set forth in § 1.703 must be reduced **44 days** based on this transaction.

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- c) Therefore, under the provisions of 37 C.F.R. § 1.704, the adjustment set forth in § 1.703 must be reduced by a total of **47 days**.

- d) The PAIR Patent Term Adjustment History indicates that Applicants are charged with an additional **120 days** of delay based on receipt of a Miscellaneous Incoming Letter dated **October 4, 2004**. It appears that these additional **120 days** of delay are in error. Specifically, the "Miscellaneous Incoming Letter" was a communication to the Examiner, in response to the Examiner's request in the Notice of Allowance for a new declaration from Dan L. Eaton. The communication to the Examiner was submitted along with payment of the issue fee, and stated:

"In the Notice of Allowance and Issue Fee(s) Due mailed 7/14/04, the Examiner requested that a substituted oath of declaration be submitted because of the date of signature of Dan L. Eaton was missing. On 9/9/04 Applicants filed a Request to Correct Inventorship pursuant to 37 C.F.R. § 1.48(b) by deleting Dan L. Eaton as an inventor. Thus, Applicants have rendered the Examiner's request moot."

Therefore, the "Miscellaneous Incoming Letter" was submitted in response to an express request of the Examiner. Pursuant to 37 C.F.R. § 1.704(c)(8), which provides that applicants should not be charged with delay when submitting a paper in response to an express request of the examiner, Applicants should not be charged with any delay as a result of the "Miscellaneous Incoming Letter" filed October 4, 2004.

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(3) Total patent term adjustment - For the present application, the total patent term adjustment under 37 C.F.R. § 1.703(f) is the period of adjustment under 37 C.F.R. § 1.703 reduced by the reduction under 37 C.F.R. § 1.704. The total adjustment is thus **284 days + 417 days + 157 days - 47 days = 811** days, not **534** days as calculated by the Office.

Applicants respectfully request reconsideration of the patent term adjustment for this patent. Office personnel are invited to contact the undersigned Attorney for Applicants via telephone if such communication would expedite this request.

Respectfully submitted,

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